



#16

MAY - 7 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

HELLER EHRMAN WHITE & McAULIFFE
4350 LA JOLLA VILLAGE DRIVE, 7TH FLOOR
SAN DIEGO, CA 92122

In re Application of :
Emory Anderson et al :
Serial No.: 09/717,478 : PETITION DECISION
Filed: November 20, 2000 :
Attorney Docket No.: 24727-813C :

This is a decision on the petition under 37 CFR 1.181, filed January 27, 2003, requesting withdrawal of the finality of an Office action.

BACKGROUND

A review of the pertinent portion of the file history shows that the examiner mailed a first Office action to applicants on May 22, 2002, in which claims 1-15 were rejected under 35 U.S.C. 112, second paragraph as indefinite citing specific terms; claims 1, 3-4 and 8-10 were rejected under 35 U.S.C. 102(a) as anticipated by Connolly; claims 2, 5-7 and 11-12 were rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Hernicz; claims 13 and 15 were rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Senyei et al; and claim 14 was rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Hernicz and Senyei et al.

Applicants replied on August 22, 2002, by canceling claim 10, amending claims 1-9 and 11-15 and adding claims 16-30. The rejections of record were addressed and arguments for patentability were set forth.

The examiner mailed a Final Office action to applicants on November 26, 2002. The examiner rejected claim 12 under 35 U.S.C. 112, second paragraph, as indefinite for a non-specific term; claims 1, 3-4, 8-9, 16-18 and 21-26 were rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Augstein; claims 5-7, 11-12 and 29-30 were rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Augstein and further in view of Hernicz; claims 13 and 15 were rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Augstein and further in view of Senyei et al; claim 14 was rejected under 35 U.S.C. 103(a) as unpatentable over Connolly in view of Augstein and Hernicz and further in view of Senyei et al; claims 19-20 were rejected under 35 U.S.C. 103(a) over Connolly in view of Augstein. Claim 2 was indicated allowable.

Applicants replied with this petition on January 27, 2003. A further amendment after Final rejection was filed on February 19, 2003, but has not been considered by the examiner.

DISCUSSION

Applicants state that each of the rejections in the second Office action include a new reference and that the new reference was not necessitated by applicants' amendment. It is noted by applicants that the claims were amended by changing "scanning a reader head" to "moving a reader head" over a surface. Connolly, the main reference of record in the first Office action teaches scanning of a test strip by a reader head. No specific teaching is given as to whether the reader head moves or the test strip moves. In the second Office action in response to the amendment which specifically requires the reader head to move, a new reference, Augstein, was added to specifically show reading a test strip by moving the reader head.

Applicants argue that "scanning" and "moving" are terms having similar, if not the same, meaning. Applicants' arguments have been carefully considered. It is clear that scanning can be accomplished in two different manners - by moving a recording device (test strip) past a stationary reader head or by maintaining the recording device stationary and moving the reader head. The first is best exemplified by a compact disk player in which the recorded disk moves past a (relatively) stationary reader head and is scanned or a store checkout counter where the item being purchased is moved past a stationary scanning head. The other is best exemplified by a bar code reader in which the recorded device is maintained stationary and a portable reader head is moved to scan the information. As applicants' specification and original claims encompassed both types of readers within the scope of the term "scanning", the Connolly reference was sufficient to reject the claims under 35 U.S.C. 102(a). Applicants' argument in the petition that scanning over a surface includes movement of the reader head is accepted inasmuch as the term, as presented in the claims, could be interpreted to mean moving the test strip or the reader head. Thus applicants' amendment did not introduce a new limitation, but merely narrowed and more particularly defined a broad limitation.

DECISION

Applicants' petition is **GRANTED**.

The Finality of the last Office action is withdrawn. The amendment after Final rejection filed February 19, 2003, will be considered a complete reply to the Office action mailed November 26, 2002, the finality of which has been withdrawn.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

Jasemine C. Chambers
Jasemine C. Chambers
Director, Technology Center 1600